

REMARKS

The Official Action mailed January 15, 2008 has been carefully considered. Reconsideration and allowance of the subject application, as amended, are respectfully requested.

Claim Amendments

Claims 12, 15-17 and 81 have been amended, claims 22, 82 and 90 have been cancelled without prejudice, and claim 91 has been added. As a result, claims 12, 14-21, 81, 83-85, 87-89 and 91 are now pending. No new matter is believed to be added.

Claim Rejection – 35 U.S.C. § 103

Claims 12, 14-22 and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walrus et al. (U.S. Patent No. 5,595,193, hereinafter “Walrus”) in view of Selmon et al. (U.S. Patent No. 6,217,549, hereinafter “Selmon”). In addition, claims 12, 14-22 and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McArthur (U.S. Patent No. 6,342,075, hereinafter “McArthur”) in view of Walrus. Applicant respectfully traverses these rejections.

At the outset, it would appear that the second rejection (i.e., McArthur in view of Walrus) intended to reject claims 81-89, not claims 12, 14-22 and 90 as written on page 3. Clarification is therefore respectfully requested.

With this amendment, Applicant has amended independent claim 12 to generally recite, *inter alia*, that the first element comprises a first contact portion having a first and a second contact surface spaced radially outwardly from the first cannulated shaft and that the second element comprises a second contact portion having a third and a fourth contact surface spaced radially outwardly from the second cannulated shaft.

Moreover, with this amendment independent claim 12 also now generally recites, *inter alia*, that the first and the second contact surfaces of the first contact portion are configured to contact with an articular surface about a first and a second opposite side of a defect site on an articular surface generally only along either one of the AP or ML curves of the articular surface. In addition, independent claim 12 now generally recites, *inter alia*, that the third and the fourth

contact surfaces of the second contract portion are configured to contact with the articular surface about a third and a fourth opposite side of the defect site generally only along the other of the AP or ML curves of the articular surface.

For the Examiner's convenience, amended independent claim 12 has been reproduced below in its entirety:

12. A guide device for locating a working axis, said device comprising:
a first element comprising a first cannulated shaft having a longitudinal axis, said first element further comprising a contact portion having a first and a second contact surface spaced radially outwardly from said first cannulated shaft; and
a second element comprising a second cannulated shaft moveably disposed along said first longitudinal axis in said cannula of said first cannulated shaft, said second element further comprising a second contact portion having a third and a fourth contact surface spaced radially outwardly from said second cannulated shaft, wherein said first and said second contact surfaces of said first contact portion are configured to contact with an articular surface about a first and a second opposite side of a defect site on an articular surface generally only along either one of the AP or ML curves of said articular surface, and wherein said third and said fourth contact surfaces of said second contract portion are configured to contact with said articular surface about a third and a fourth opposite side of said defect site generally only along the other of the AP or ML curves of said articular surface,
wherein the longitudinal axis is configured to be oriented substantially normal to said articular surface when said contact surfaces of said first and said second contact portions contact said articular surface, and wherein said cannula of said second cannulated shaft is configured to receive a tool along said longitudinal axis of first element to be driven substantially normal into an articular surface of bone

Turning now to Walnut, Applicant respectfully submits that Walnut is understood to disclose a guide assembly 10 that "is made up of two principal components ...a guide housing 12, and a cannula guide tube subassembly 20" (see Walnut, col. 4, lines 57-60 and FIGS 1-3.) The present Office Action is understood to suggest that the cannula guide tube 22 of the cannula guide tube subassembly 20 (FIGS. 1 and 2) and the temporary marker base 60 of the marker insertion tool 72 (FIGS. 7 and 8) read on the contact surfaces of the first element of independent claim 12. The present Office Action is further understood to suggest that the base 14 of the guide housing 12 reads on the contact surfaces of the second element of independent claim 12

Upon review of Walnut, and in particular the sections noted in the present Office Action, Applicant respectfully submits that Walnut is not understood to disclose or suggest a first

element comprising a first contact portion having a first and a second contact surface spaced radially outwardly from the first cannulated shaft and a second element comprising a second contact portion having a third and a fourth contact surface spaced radially outwardly from the second cannulated shaft as generally recited in amended, independent claim 12. In particular, as may be appreciated based on FIGS. 1-3 of Walnut, the cannula guide tube 22 of the cannula guide tube subassembly 20 is not understood to be spaced radially outwardly from the shaft. In fact, the element referenced in the present Office Action (i.e., the cannula guide tube 22 of the cannula guide tube subassembly 20) is understood to be the shaft. Referring now to the temporary marker base 60 of the marker insertion tool 70 as shown in FIGS. 7 and 8, Applicant respectfully submits that the temporary marker base 60 is also not understood to be disposed spaced radially outwardly from a shaft. Accordingly, Applicant respectfully submits that Walnut is not understood to disclose or suggest a first element comprising a first contact portion having a first and a second contact surface spaced radially outwardly from the first cannulated shaft and a second element comprising a second contact portion having a third and a fourth contact surface spaced radially outwardly from the second cannulated shaft as generally recited in amended, independent claim 12.

Applicant also respectfully submits that none of the elements of Walnut suggested in the present Office Action as reading on the contact surfaces of the first and second elements are understood to contact with an articular surface about opposite sides of a defect site on an articular surface generally only along either one of the AP or ML curves of said articular surface as generally recited in amended, independent claim 12. For example, the base 14 of the guide housing 12 of Walnut is understood to define a generally conical shape as shown in FIG. 12a. As such, Applicant respectfully submits that one of ordinary skill in the art would, at best, understand the base 14 of Walnut to contact the entire surface of an articular surface about a defect site including both the AP and ML curvatures. In addition, both the cannula guide tube 22 (FIGS. 1 and 2) and the temporary marker base 60 (FIGS. 7 and 8) of Walnut are understood to be generally tubular. As such, Applicant again respectfully submits that one of ordinary skill in the art would, at best, understand both of these to contact the entire surface of an articular surface about a defect site including both the AP and ML curvatures. Accordingly, Applicant

respectfully submits that Walnut is not understood to disclose or suggest that the contact surfaces of the first and second contact portions are configured to contact with an articular surface about opposite sides of a defect site on an articular surface generally only along either one of the AP or ML curves of the articular surface as generally recited in amended, independent claim 12.

Turning now to Selmon, Applicant respectfully submits that Selmon is not understood to disclose or suggest the deficiencies of Walnut discussed above. Upon review of Selmon, Selmon is understood to disclose an intravascular catheter system. As such, Applicant respectfully submits that it is not clear how or in what manner this reference could be combined with Walnut. More specifically, Applicant respectfully submits that one of ordinary skill in the art would not understand Selmon to disclose or suggest locating a working axis “orientated substantially normal to said articular surface when said contact surfaces of said first and said second contact portions contact said articular surface” as generally recited in amended, independent claim 12. Reconsideration is therefore respectfully requested.

In addition, Applicant respectfully submits that Selmon is not understood to disclose or suggest a first element comprising a first contact portion having a first and a second contact surface spaced radially outwardly from the first cannulated shaft and a second element comprising a second contact portion having a third and a fourth contact surface spaced radially outwardly from the second cannulated shaft as generally recited in amended, independent claim 12. While the present Office Action does not provide any explanation regarding what elements of Selmon are being relied upon, Applicant notes that the ferrule 56 of the guidewire tube 54 is understood to have a generally conical shape (for example, as shown in FIG. 10.) As such, Applicant respectfully submits that one of ordinary skill in the art would, *at best*, understand the ferrule 56 to contact the entire surface of an articular surface about a defect site including both the AP and ML curvatures. Again, Applicant would like to reiterate that nothing in Selmon is understood to disclose or suggest that the catheter system may locate a working axis “orientated substantially normal to said articular surface when said contact surfaces of said first and said second contact portions contact said articular surface” as generally recited in amended, independent claim 12. Accordingly, Applicant respectfully submits that Selmon does not disclose or suggest all of the limitations missing from Walnut.

In light of the above, Applicant respectfully submits that the combination of Walnut and Selmon does not disclose or suggest all of the limitations recited in amended, independent claim 12. The remaining claims depend, either directly or indirectly, from independent claim 12. Therefore, Applicant respectfully submits that the remaining claims are also allowable by virtue of their dependency from independent claim 12 in addition to their own patentable limitations. Accordingly, reconsideration and withdrawal of the rejection of claims 12, 14-22 and 90 under 35 U.S.C. § 103(a) over the combination of Walnut and Selmon is respectfully requested.

Turning now to the rejection in view of the combination of MacArthur and Walnut, Applicant would again like to reiterate that this rejection will be addressed with respect to claims 81-89, not claims 12, 14-22 and 90 as stated on page 3 of the present Office Action.

With this amendment, independent claim 81 now recites a “method for replacing a portion of an articular surface of bone generally defined by an anterior-posterior (AP) and a medial-lateral (ML) curve using a device comprising a first element comprising a first contact surface mounted to a first cannulated shaft, and a second element comprising a second contact surface mounted to a second cannulated shaft, said second contact surface configured to move with respect to the first contact surface,” wherein the method comprises, *inter alia*:

establishing an axis generally normal to the portion of the articular surface of bone to be replaced based on said ML curve and said AP curve of said articular surface, comprising:

contacting said first contact surface with said articular surface about a first and a second opposite side of a defect site on an articular surface generally only along either one of said AP or said ML curves of said articular surface; and

contacting said second contact surface with said articular surface about a third and a fourth opposite side of said defect site generally only along the other of said AP or said ML curves of said articular surface.

Applicant notes that the present Office Action suggests on page 4 that “Mac Arthur discloses a method comprising establishing an axis generally normal to the portion of the articular surface of a bone to be replaced; as best seen in FIGS. 8 a-d.” Upon review of MacArthur, Applicant is unable to find any teaching or suggestion of these limitations. For example, Applicant respectfully submits that MacArthur is not understood to disclose or suggest

“establishing an axis generally normal to the portion of the articular surface of bone to be replaced based on said ML curve and said AP curve of said articular surface” as generally recited in amended, independent claim 81. Moreover, MacArthur is not understood to disclose or suggest contacting the first and second contact surfaces the articular surface about opposite sides of a defect site on the articular surface generally only along either one of said AP or said ML curves as generally recited in amended, independent claim 81.

As discussed above, Applicant also respectfully submits that Walnut is also not understood to disclose or suggest the deficiencies of MacArthur discussed above. For example, Walnut is not understood to disclose or suggest contacting the first and second contact surfaces the articular surface about opposite sides of a defect site on the articular surface generally only along either one of said AP or said ML curves as generally recited in amended, independent claim 81.

Accordingly, Applicant respectfully submits that the combination of MacArthur and Walnut does not disclose or suggest all of the limitations recited in amended, independent claim 81. The remaining claims depend, either directly or indirectly, from independent claim 81. Therefore, Applicant respectfully submits that the remaining claims are also allowable by virtue of their dependency from independent claim 81 in addition to their own patentable limitations. Accordingly, reconsideration and withdrawal of the rejection of claims 81-89 under 35 U.S.C. § 103(a) over the combination of MacArthur and Walnut is respectfully requested.

Having dealt with all the objections raised by the Examiner, it is respectfully submitted that the present application, as amended, is in condition for allowance. Thus, early allowance is earnestly solicited.

If the Examiner desires personal contact for further disposition of this case, the Examiner is invited to call the undersigned Attorney at 603.668.6560.

In the event there are any fees due, please charge them to our Deposit Account No. 50-2121.

Respectfully submitted,

AMENDMENT

Serial Number: 10/618,887

Filing Date: July 14, 2003

Title: System and Method for Joint Resurface Repair

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